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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/822,397	03/20/1997	BARRY H. SCHWAB	VID-00203/29	6309

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EXAMINER

BROWN, RUEBEN M

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 07/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

08/822,397

Applicant(s)

SCHWAB ET AL.

Examiner

Reuben M. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 5/8/2003 have been fully considered but they are not persuasive. Applicant argues that, "it would have been obvious to one of skill in the art, including the instant inventors, that the claims currently pending find support in the specification an claims as originally filed". Examiner respectfully disagrees. By way of example, on page 5, lines 18-23, the specification states, "a primary channel will typically carry "primary" program information along with additional information used by the system for directing a second tuner to a secondary channel". There is no disclosure that explicitly teaches that the additional information may be used to switch the system, for instance from the cable source to the satellite source or broadcast source, or vice versa.

The originally filed claim 1 recites, "assign and re-assign user defined channels designations to channels present on any of the associated inputs, and store the designation for future use, and selectively route a TV program from any of the associated inputs to the output for viewing on the display device, the switching of the particular input being a function of the user defined channel designations". Examiner finds no basis in the above recitation, for the presently claimed feature of, "transmitting from a broadcaster to the viewing location, a TV program on a primary transmission medium the program including additional information for directing the

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channel selector to automatically switch, at least temporarily, to one or more secondary transmission media", as recited in claim 26, and similarly recited in claims 18, 23-25 & 39-40.

Examiner asserts that despite applicant's argument, it is not inherent that a channel change command would be required to also control the tuner on a different transmission medium. For instance, tuning of TV programs using the analog transmission medium of Broadcast TV (i.e., UHF & VHF) is not the same as tuning of TV programs using satellite TV or broadband transmission generally found in CATV. Therefore the technology required to tune TV programs on the single transmission medium, is not as involved as switching over to a different transmission medium, using a different transmission algorithm.

In order to overcome the 112, 1<sup>st</sup> paragraph rejection, applicant must demonstrate that the subject matter recited in the claims was present in the original specification or original claims.

In view of the above arguments, examiner maintains the 112 first paragraph rejection.

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*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 18-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Considering claim 18, the amended claimed feature of, “automatically switching the TV program to the alternative transmission based on the information previously entered by the viewer without requiring any additional viewer intervention at the time of switching”, does not find explicit support in the specification or original claims. Claims 19-25 depend from claim 18 and are likewise treated.

Considering claim 23, the instant claim requires that the information for automatically switching the TV channel to an alternate transmission medium is downloaded from a computer. Therefore the claim 23 is analyzed in the same manner as claim 26.

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Considering claim 26, the recited feature of the instant claim calls for, “transmitting, from a broadcaster to the viewing location, a TV program on a *primary transmission medium*, the program including additional information for directing the channel selector to automatically switch, at least temporarily to one or more *secondary transmission media*, which is not found in the specification, emphasis added.

On page 5 of the specification, it is disclosed that a primary channel may include additional information for directing a second tuner to a secondary channel. However, the specification does not explicitly state that this secondary channel may be on a transmission media different from the primary channel.

As pointed out above, even though original claim 8 recites automatically switching to another channel to tune to a TV program, it does not explicitly recite that the another channel may be located on a secondary transmission media, different from the first transmission media.

Claims 27-33 depend from claim 26, and are likewise treated.

Considering claims 24 & 25, and 39-40, the amended claimed features require data transmitted continuously with a TV program or at the initiation of a TV program, which automatically switches the instant TV program from a first transmission medium, to an alternate transmission medium. Since claims 24 & 25 require that the switching to a different transmission

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medium is in response to transmitted data, instead of a user selection, the instant claims are treated in the same manner as claim 26.

Considering claim 34, the instant claim requires that a channel change command included in a TV program is detected by equipment at a TV viewing location, in response to the detected channel change command, a different transmission is selected. Again, examiner finds no disclosure in the specification or original claims for a channel change command included in a TV program that leads a subscriber TV equipment to automatically changing to a different transmission medium.

Claims 35-40 directly or indirectly depends from claim 34, and are likewise treated.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 872-9314 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")


*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399.  
The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the  
organization where this application or proceeding is assigned is (703) 872-9314 for regular  
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown

  
ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600